

REMARKS/ARGUMENTS

The Office Action mailed June 20, 2007, has been received and reviewed. Claims 37-39 and 55-64 are currently pending in the application. Claims 37-39 and 55-64 stand rejected. Claim 55 has been objected to as being dependent upon rejected base claims, but the indication of allowable subject matter in such claims is noted with appreciation. Applicants have amended claims 55 and 60, and respectfully request reconsideration of the application as amended herein.

Claim Objections

Claim 55 is objected to due to informalities in the claim language. Appropriate correction has been made.

35 U.S.C. § 112 Claim Rejections

Claims 60-64 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicants respectfully traverse this rejection, as hereinafter set forth.

Applicants have amended claim 60 to recite the interrelatedness of the various steps. Accordingly, Applicants respectfully request the rejections of claims 60-64 be withdrawn.

35 U.S.C. § 103(a) Obviousness Rejections

Obviousness Rejection Based on U.S. Patent No. 5,951,703 to Sprouse et al.

Claims 37-39 and 55-64 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Sprouse et al. (U.S. Patent No. 5,951,703). Applicants respectfully traverse this rejection, as hereinafter set forth.

To establish a *prima facie* case of obviousness the prior art reference (or references when combined) **must teach or suggest all the claim limitations**. *In re Royka*, 490 F.2d 981, 985 (CCPA 1974); *see also* MPEP § 2143.03. Additionally, there must be “a reason that would have prompted a person of ordinary skill in the relevant field to combine the [prior art] elements” in the manner claimed. *KSR Int’l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1742, 167 L.Ed.2d 705, 75 USLW 4289, 82 U.S.P.Q.2d 1385 (2007). Finally, to establish a *prima facie* case of obviousness

there must be a reasonable expectation of success. *In re Merck & Co., Inc.*, 800 F.2d 1091, 1097 (Fed. Cir. 1986). Furthermore, the reason that would have prompted the combination and the reasonable expectation of success must be found in the prior art, common knowledge, or the nature of the problem itself, and not based on the Applicant's disclosure. *DyStar Textilfarben GmbH & Co. Deutschland KG v. C. H. Patrick Co.*, 464 F.3d 1356, 1367 (Fed. Cir. 2006); MPEP § 2144. Underlying the obvious determination is the fact that statutorily prohibited hindsight cannot be used. *KSR*, 127 S.Ct. at 1742; *DyStar*, 464 F.3d at 1367.

The 35 U.S.C. § 103(a) obviousness rejections of claims 37-39 and 55-64 are improper because the elements for a prima facie case of obviousness are not met. Specifically, the rejection fails to meet the criterion that the prior art reference must teach or suggest all the claims limitations.

Regarding independent claim 37 and claims 38, 39 and 55-64 depending therefrom, Applicants' independent claim 37 includes claim limitations not taught or suggested in the cited references.

Applicants' independent claim 37 recites:

37. A method of preventing a circuit having a test mode entry function from entering a subsequent test mode after the circuit enters a first test mode, comprising:
initiating a test mode blocking signal after the circuit completes the first ***test mode***; and
exclusively controlling the test mode entry function of the circuit ***with the test mode blocking signal***. (Emphasis added.)

The Office Action alleges:

Sprouse teaches the invention substantially as claimed. ...

Sprouse does not explicitly teach the initiating a test mode block signal. Sprouse, however, teaches that the scan control logic (20) asserts a scan signal to initiate the scan test mode (column 5 lines 26-36).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to realize that Sprouse's scan control logic (20) would have also assert[ed] a hold signal or a bypass signal to initiate the normal mode. One having ordinary skill in the art would be motivated to realize so because Sprouse teaches that normal (non-test) operation is formed when scan control logic (20) asserts the hold signal, or both bypass and scan signals (column 6 lines 39-46,

column 6 lines 18-24). (Office Action, pp. 3-4.)

Generally, Applicants' invention as claimed recites "*after ... the ... test mode*", "*initiating a ... signal*" and "*exclusively controlling the test mode entry ... with the ... signal.*"

In short, Applicants' invention as claimed initiates a signal (e.g., blocking signal) after a mode (e.g., test mode) the signal becomes "exclusively controlling" of getting back to the previous mode (e.g., test mode). In contrast, Sprouse teaches that modes are *entered into and subsequently returned to in the very same manner and in response to the very same signals* that caused the initial entry to the mode. Specifically, Sprouse teaches:

... the system is *switched from* the first or run *mode to* the scan *mode* for receiving pseudo-random bit patterns that are scanned into the scan strings to place the system in a pseudo-random state. The technique may include the step of *returning* the system momentarily *to* its run *mode* configuration, and permitting it to operate for one clock cycle. The system is *then returned to* the scan *mode*, the digital state (i.e., the content of the scan string or strings) extracted (again by scanning), and that state then analyzed to determine the operability of the stages and interconnections of the system, and thereby the system itself. (Sprouse, col. 1, lines 51-62; emphasis added).

... the subsystems 12 will be designed to be *selectively placed in one of two modes of operation in response the to* the scan test *signals* supplied by the scan control logic 20: normal mode, or scan mode. (Sprouse, col. 4, lines 37-40; emphasis added).

From the viewpoint of the subsystems 12, when the scan control logic 20 asserts the scan signal *to initiate the* scan test *mode*, (Sprouse, col. 5, lines 26-28; emphasis added).

When *placed in* a scan *mode* by the control logic 20 (Sprouse, col. 5, line 61; emphasis added).

Hold, scan, and bypass are the test signals asserted by the scan control logic 20 during scan mode of operation. (The bypass test signal is also used to wall off non-scannable circuitry--not shown--during the scan process.) Thus, the stages of the counter 54 will be *placed in* hold *state when* the scan control *logic 20 asserts* (1) the hold *signal*, or (2) *both* the bypass and scan *signals*. (Sprouse, col. 6, lines 18-24; emphasis added).

Sprouse clearly teaches of modes and states and signals that cause the system to enter modes and states. However, the system as taught by Sprouse "*return[s]*" *to those modes or states* and are "*selectively placed*" *into those modes or states on subsequent occurrences*

according to the very same signals that caused the system to originally enter those modes or states. Such teaching is in distinct contrast to Applicants' invention as presently claimed in independent claim 37 which recites, in part, "*after ... the ... test mode*", "*initiating a ... signal*" and "*exclusively controlling the test mode entry ... with the ... signal.*"

Therefore, since Sprouse does not teach or suggest Applicants' claimed invention including "*after ... the ... test mode*", "*initiating a ... signal*" and "*exclusively controlling the test mode entry ... with the ... signal*", Sprouse cannot render obvious, under 35 U.S.C. §103, Applicants' invention as presently claimed in independent claim 37. Accordingly, Applicants respectfully request the rejection of independent claim 37 be withdrawn.

Furthermore, when the "proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification." M.P.E.P. §2143.01 (citing *In re Gordon*, 733 F.2d 900, 221 U.S.P.Q. 1125 (Fed. Cir. 1984)). Accordingly, the alleged modification of Sprouse to "*after ... the ... test mode*", "*initiat[e] a ... signal*" and "*exclusively controll[] the test mode entry ... with the ... signal*" would destroy the intended purpose of Sprouse "*return[ing] to those modes or states* and being "*selectively placed into those modes or states on subsequent occurrences*" according to the same signals that caused the system to originally enter those modes or states.

For these reasons, Applicants assert that a 35 U.S.C. § 103 rejection of independent claim 37 based on Sprouse is improper and must be withdrawn. Therefore, Applicants respectfully request the rejection be withdrawn.

The nonobviousness of independent claim 37 precludes a rejection of claims 38, 39 and 55-64 which depend therefrom because a dependent claim is obvious only if the independent claim from which it depends is obvious. See *In re Fine*, 5 U.S.P.Q.2d 1596, 1600 (Fed. Cir. 1988), see also MPEP § 2143.03. Therefore, Applicants request that the Examiner withdraw the 35 U.S.C. § 103(a) obviousness rejection to independent claim 37 and claims 38, 39 and 55-64 which depend therefrom.

CONCLUSION

Claims 37-39 and 55-64 are believed to be in condition for allowance, and an early notice thereof is respectfully solicited. Should the Examiner determine that additional issues remain which might be resolved by a telephone conference, he is respectfully invited to contact Applicants' undersigned attorney.

Respectfully submitted,



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